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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,344	08/05/2003	Ronald P. Laliberty	043596.091	6750

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,344

Applicant(s)

LALIBERTY ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-11 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang (5,704,858) in view of Talarico et al. (5,951,420) and Walker et al. (5,647,590). Note the basis for the rejections set forth in the Office Actions mailed January 18, 2005 and August 4, 2005. Regarding the added limitation in claims 1 and 14 for the ball to be a competitive game ball, the balls of Yang, Talarico and Walker are obviously capable of being used in competitive game play. Further, the limitation occurs in the preamble of the claim.

Regarding the limitation in claims 1 and 14 for the core to have a coefficient of restitution between 0.40 and 0.50 at 88 feet/second, note the rejections of claims 12 and 19 in the Office Actions mailed January 18, 2005 and August 4, 2005. Walker teaches a coefficient of restitution of less than 0.45 at 88 feet/second (column 2, lines 3-7).

Regarding the amendments to claims 13, 20 and 21, the limitations are considered to be obvious given the teachings of Yang in view of Talarico and Walker and the lack of a showing of the criticality of the claimed ranges by a new and unexpected result obtained therefrom.

Response to Arguments

3. Applicant's arguments filed October 28, 2005 have been considered but are not persuasive. The applicant argues that the elimination of the layer (12) from the ball of Yang would create a hard ball that is no longer suitable for children. However, this argument is not persuasive as Yang clearly states that other layers also provide the cushioning for the ball. Note column 2, lines 13-16 stating that the third layer (14) forms a soft cushioning layer so as to

prevent the player from being hurt by the baseball. While the removal of the layer (12) from the ball of Yang would create a harder baseball, the intended purpose of the ball would still remain due to the presence of the soft layer (14). Regarding the limitation for the ball to be a "competitive" game ball, this limitation relates to the intended use of the ball. Clearly, the ball of Yang is capable of being used in a competitive environment. Further, the limitation occurs in the preamble of the claim.

The recitation "competitive" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding the reference to Talarico, the applicant argues that the structure of Talarico is reversed from that of Yang. The applicant further states that Talarico is also directed to a safety ball that is not intended for competitive play. However, these arguments are not persuasive as the reference to Talarico is merely relied upon for its teaching that it is well known in the art of baseballs to use polyurethane material in order to take advantage of that material's well known physical characteristics. Further, like Yang, the ball of Talarico is obviously capable of being used in competitive game play.

Regarding the reference to Walker, the applicant argues that the ball of Walker is directed to a reduced flight distance ball and not a competitive ball. Further, the applicant argues that the COR of Walker is less than that of the instant claims. However, these arguments are not

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persuasive as the ball of Walker, like the balls of Yang and Talarico is obviously capable of being used in competitive game play. Walker provides a game ball that has a softer and slower center or core for use on smaller playing ball fields yet is also suitable for competitive game play (note column 1, lines 49-62). Regarding the limitation for the COR, Walker teaches a COR of less than 0.45 at 88 feet per second. Thus, while the range extends lower than that of applicant's range, a COR of 0.40 to 0.45 as taught by Walker reads on the applicant's claimed range.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
March 27, 2006